



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,692	11/20/2003	Xue Hua Qiu	104220-471-NP	9320
24964	7590	10/17/2005	EXAMINER	
GOODWIN PROCTER L.L.P 103 EISENHOWER PARKWAY ROSELAND, NJ 07068			WILLIAMS, KENNETH C	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/717,692		QIU, XUE HUA	
	Examiner		Art Unit	
	Kenneth C. Williams		3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/20/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Figures 1a, 2a, 3a, 4a and 5

Species II: Figures 1b, 2b, 3b and 4b

Species III: Figures 6a-b, 7 and 8

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Eva Tan on 9/27/05 a provisional election was made without traverse to prosecute the invention of Species I, claims 1, 4 and 5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2, 3 and 6-10 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Taiwan on 03/05/03. It is noted, however, that applicant has not filed a certified copy of the 092104645 application as required by 35 U.S.C. 119(b).

Specification

4. The disclosure is objected to because of the following informalities:
- a. On page 5, line 7, "that hysterectomy" should be changed to read --that a hysterectomy--.
 - b. On page 9, line 16, "the distal end" should be changed to read --the distal end--.
 - c. On page 11, line 5, "generator 11" should be changed to read --generator 9--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being unpatentable by Lorentzen (U.S. Patent No. 5951546).

a. In regards to Claim 1, Lorentzen discloses an electrosurgical apparatus comprising “a substantially hollow elongated body terminating in a sharp closed cutting head” (See Figure 1, element 16; see also column 9, lines 41-49), “an insulative layer covering said elongated body” (See Figure 1, element 12; see also column 9, lines 49-52), “said elongated body forming a portion of a coolant path” (See Figure 2a; see also column 10, lines 5-9), “a handle located at an end of said elongated body opposite from said cutting head” (See Figure 1, element 20; see also column 9, lines 57-62), “coolant inlet/outlet connectors connected to said handle for introducing a coolant into said coolant path of said elongated body and releasing said coolant therefrom” (See Figure 1; see also column 9, lines 58-67) and “a radio-frequency energy input connector connected to said elongated body” (See column 10, lines 1-4). The examiner notes the reference does not specifically state that a handle is a part of the device, but Figure 1, element 20 contains the structure of a handle.

b. In regards to Claim 4, Lorentzen discloses an electrosurgical apparatus comprising "said elongated body comprises two metal tubes with different diameters, one with a smaller diameter being disposed coaxially within the other with a bigger diameter" (See column 9, lines 42-44 and lines 54-56).

c. In regards to Claim 5, Lorentzen discloses an electrosurgical apparatus comprising "said insulative layer is a medical insulative paint or an insulative tube surrounding said elongated body" (See Figure 2a, element 12; see also column 9, lines 49-52).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth C. Williams whose telephone number is (571) 272-8161. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCW

A handwritten signature in black ink, consisting of a large, stylized 'L' and 'D' with a smaller 'C' and 'M' integrated into the design.

LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3700